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| APPLICATION NO.                                                                                                              | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------------------------------------|-------------|----------------------|------------------------------|------------------|
| 09/489,171                                                                                                                   | 01/21/2000  | Frank A. Doljack     | DOLJP103WOUSA                | 5489             |
| 23908 7590 12/21/2006<br>RENNER OTTO BOISSELLE & SKLAR, LLP<br>1621 EUCLID AVENUE<br>NINETEENTH FLOOR<br>CLEVELAND, OH 44115 |             |                      | EXAMINER<br>CALLAHAN, PAUL E |                  |
|                                                                                                                              |             |                      | ART UNIT<br>2137             | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE                                                                                       |             | MAIL DATE            | DELIVERY MODE                |                  |
| 3 MONTHS                                                                                                                     |             | 12/21/2006           | PAPER                        |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/489,171

Applicant(s)

DOLJACK

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-60, 62-67, 87, 94-96, 100 and 101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-52, 62-67, 87 and 94-96 is/are allowed.
- 6) ☒ Claim(s) 53-60 is/are rejected.
- 7) ☐ Claim(s) 100 and 101 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The Applicant's has petitioned to withdraw the holding of abandonment in the previous Office Action, mailed 8-22-06. The petition has been considered and the Applicant's claim that the failure to timely file a proper response to the final Office Action, mailed 2-7-2006, was inadvertent has been approved in the decision rendered 12-1-2006.

2. Claims 44-67 and 77-107 were pending in the instant application at the time of the previous Office Action. By the latest amendment, filed 8-7-06, claims 44, 61, 77-86, 88-93, 97-99, and 102-107 are additionally cancelled. Therefore, claims 45-60, 62-67, 87, 94-96, 100, and 101 are pending and have been examined.

### ***Specification***

3. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

4. Claim 100 is objected to because of the following informalities: The claim contains the passage: "...obtaining a non-random code including at least a secret portion that is encrypted to be readable (decrypted properly) only by use of a private

Art Unit: 2137

key." The phrase is somewhat unclear since the term "decrypted properly" is ambiguous. The applicant may wish to amend the claim to read as something similar to: "...obtaining a non-random code including at least a secret portion that is encrypted ~~to be readable (decrypted properly)~~ [so as to be decrypted] only by use of a private key."

Appropriate correction is required. Claim 101 is dependent on claim 100 and is therefore objected to on the same basis as is that claim.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 53-60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-29 of U.S. Patent No. 6,442,276. Although the conflicting claims are not identical, they are not patentably

distinct from each other because Claims 18-29 of the Patent contain every element of claims 53-60 of the instant application and as such anticipate the claims of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

***Allowable Subject Matter***

7. Claims 45-52, 62-67, 87, and 94-96 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art in the field, Gilham US 4,934,846, and Storch US 5,367,148, do not teach the combination of features found in independent claims 62, 64, 87, 94, and 95, particularly including the combination code comprising a random portion and a non-random portion where the non-random portion includes a secret portion that is encrypted, all in the manner of the applicant as disclosed in his specification.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

PEC

12-14-06

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER